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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,802	09/22/2000	Shigefumi Wada	4495-006	9689

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EXAMINER

SNYDER, DAVID A

ART UNIT

PAPER NUMBER

2122

DATE MAILED: 04/10/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/667,802

Applicant(s)

WADA ET AL.

Examiner

David A Snyder

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/667802, filed on 22 Sep 2000.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: item S22 of fig. 2. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Examples follow:

Claims 1 and 8 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter. Merely claiming the computer programs represented by computer listings, data structures, or program listing *per se* (computer readable code), that is, descriptions or expressions of such a program that are descriptive material *per se* (non-functional descriptive material), are non-statutory because they are

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neither physical “things” nor statutory processes, as they are not “acts” being performed. Such claimed computer programs or data structures do not define any structural and functional interrelationships between the computer program and other claimed aspects of the invention which permit the computer program’s functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, *the computer program itself, or a description of a data structure of the computer program, is not a process without the computer-readable medium needed to realize the computer program’s functionality.* In contrast, a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program’s functionality to be realized, and is thus statutory. **Warmerdam**, 33 F.3d at 1361, 31 USPQ2d at 1760. **In re Sarkar**, 588 F.2s 1330, 1330, 200 USPQ 132, 137 (CCPA 1978). See Examination Guidelines for Computer-Related Inventions – Final Version, pages 8 – 10. See M.P.E.P. § 2106(IV)(B)(1)(a).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 and 8 are also rejected under 35 U.S.C. 112, second paragraph, because the Applicant does not specify whether the invention is a method or an apparatus. The Examiner interprets the claims as an apparatus. The specification and claims are replete with numerous 35 U.S.C. 101 and 35 U.S.C. 112, first and second paragraph, problems. Examples follow:

Claims 1 and 8 are further rejected under 35 U.S.C. 112, second paragraph, because the Examiner is unclear on the phrases "writing/processing", "write-processings", "relational-database-storage/processing", and "data-accepting/processing". Are these limitations applicable to writing, storing, accepting (inputting), or processing? The Examiner interprets the above phrases as meaning the first portion of the conjugate word.

Claim 8 is further rejected under 35 U.S.C. 112, second paragraph, because the claims recites the limitation "said general-purpose data text file" in pg. 23, line 10. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 is further rejected under 35 U.S.C. 112, second paragraph, because the Examiner is unclear on the phrase, "the aforementioned customized conditions;" (pg. 23, line 5). The Examiner notes no aforementioned conditions, customized or otherwise. And as the Examiner notes only one condition following the above-mentioned phrase, the Examiner interprets the phrase as "the following condition;"

Claim 8 is further rejected under 35 U.S.C. 112, second paragraph, because the Examiner is unclear on the phrase, "data's data-accepting/processing functions group" (pg. 23, line 9). The Examiner is unaware of a data-accepting functions group of data.

Claim 8 is further rejected under 35 U.S.C. 112, second paragraph, because the Examiner is unclear on the phrase, "an application batch program is generated by using the module for entering data's data-accepting/processing functions group that corresponds to the customized conditions of each table in the database when said general-purpose data text file is entered and processed" (pg. 23, ll. 8 - 11). Is the application

generated by the module or does the application, generated by a third-party program, use the functions of the module? And if the application uses the module functions, what generates the application? The Examiner interprets the claim limitation as the application uses the functions of the module.

7. Claims 6, 7, 10, and 11, as applied to claims 1 and 8 above, are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for depending on claims which omit essential elements, such omissions amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are:

As per claims 6, 7, 10, and 11, the methods are disclosed in the parent claims of 1 and 8. Claims 1 and 8 have no limitations regarding the "selling" methods of claims 6, 7, 10, and 11. Therefore, the limitation of claims 6, 7, 10, and 11 are invalid limitation of claims 1 and 8 and will not be examined.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 – 11 are rejected under 35 U.S.C. 102(b) as being anticipated by the Navision Financials ® program by Navision Software (Navision Financials prospectus, <http://web.archive.org/web/19980130120449/www.navision.com/product/navision/factsheets/default.asp>; hereafter referred to as the Navision program).

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As per claims 1, the Navision program teaches “creating a primary dump default file” including the contents of the database (Navision program, pg. 7, “Consistent Data”);

The Navision program also discloses “a dynamic link library (DLL)” that handles different conditions (Navision program, pg. 12, “Customer Ledge Entries”, to pg. 14, “Reports and Documentation”);

The Navision program also teaches “a default dump file is created” (Navision program, pg. 33, “Export the results of your work”);

The Navision program also discloses adding columns or new tables to the database (Navision program, pg. 6, “Fully Integrated Development”, and pg. 14, “Design and modifications”);

The Navision program also teaches the ability to generate an application into a database (Navision program, pg. 6, “Fully Integrated Development”);

The Navision program also discloses a program with plural administrative task programs (Navision program, pg. 1 – 3);

The Navision program also teaches a program having a relational database (Navision Program, pg. 7, “Version Database”).

As per claim 8, the Navision program also discloses “a dynamic link library (DLL)” that handles different conditions (Navision program, pg. 12, “Customer Ledge Entries”, to pg. 14, “Reports and Documentation”);

The Navision program also teaches the data is entered (Navision program, pg. 14, “Design and modification”);

The Navision program also discloses the ability to generate an application into a database (Navision program, pg. 6, "Fully Integrated Development");

The Navision program also teaches the data being written to the database an application with a "basic-tasks program" comprised of administrative tasks and a relational database (Navision program, pg. 1 - 3).

The claims 2 - 7, and 9 - 11 are also rejected. The non-application of art to the dependent claims is not an indication of allowability of these claims, but rather the numerous faults in the Application.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 6, 7, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Navision program brochure.

As per claims 6, 7, 10, and 11, as applied to claims 1 and 8 above, the Navision program brochure does not explicitly disclose selling the Navision program or show how the Navision program can be advertised for sale. However, the obvious use of the Navision program brochure is to sell the program. Thus, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art the Navision program had to be sold, in some manner. One of ordinary skill in the art would have

been motivated to do this in order to continue the Navision Software company and Navision program.

The Navision program also does not explicitly disclose advertising parts or portions of the Navision program on the company's Website on the Internet. However, the obvious meaning of displaying the Navision program brochure on the Internet is so that the Navision program is advertised on the Internet. Thus, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art that the Navision program could be advertised on a Website on the Internet. One of ordinary skill in the art would have been motivated to do this in order to advertise to a world-wide audience at a minimal cost-per-viewer.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Great Plains ® program of Great Plains Software, a division of Microsoft Corp. (the Great Plains Accounting brochure, http://web.archive.org/web/20000304025004/www.greatplains.com/accounting/modules_f.asp; hereafter referred to as the Great Plains program) also shows a "basic-tasks" program integrated with a relational database.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A Snyder whose telephone number is (703) 305-7205. The examiner can normally be reached on Monday - Friday from 9am - 5pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg A Morse can be reached on (703) 308-4789. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

dAs
April 2, 2003


GREGORY MORSE
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